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EXAMINER

WANG, SHENGJUN

ART UNIT	PAPER NUMBER
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1617

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/965,792
Filing Date: October 01, 2001
Appellant(s): BERNARD ET AL.

Paper No. 20040528

MAILED

JUN 07 2004

GROUP

Thalia V. Warnement
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed March 29, 2004.

(1) *Real Party in Interest*

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A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

The brief does not contain a statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief. Therefore, it is presumed that there are none. The Board, however, may exercise its discretion to require an explicit statement as to the existence of any related appeals and interferences.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

The rejection of claims 1-9, 15-22, 43-70 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

US Patent 5,965,116	Mondet et al.	October 12, 1999
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(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

1. Claims 1-9, 15-22, 43-70 are rejected under 35 U.S.C. 103(a)

These rejections are fully set forth in prior office action, paper No. 8.

(11) Response to Argument

Claims 1-9, 15-22, and 43-70 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mondet et al (US Pat. 5,965,1 16).

The instant invention is drawn to a composition comprising a copolymer latex combined with two organic solvents. A variety of solvents are claimed based on their boiling point. Weight percentages of the monomeric constituents of the copolymer are claimed. Additional components suitable for formulating a cosmetic composition, particularly a nail varnish, are claimed. In response to restriction and species election requirements, applicants elected species of polymer obtained from six named monomers, as well as propylene glycol n-butyl ether and diethyl sebacate as first and second solvents, respectively. The composition comprising propylene glycol n-butyl ether, diethyl sebacate, and a polymer obtained by polymerization of acrylic acid, n-butyl acrylate, lauryl acrylate, methacrylate, tert-butyl actylate, and styrene is free of the prior art. Search has extended to the nonelected species (see paper No. 8).

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Mondet teaches cosmetic compositions comprising a copolymer comprising at least three different monomers and having glass transition temperatures greater than 150 Celsius (see especially claim 11). It is noted that a polymer from the prior art that has the same chemical composition as claimed in the instant application necessarily has the same physical properties. The copolymers of Mondet contain unsaturated carboxylic acid monomers, (meth)acrylic acid ester monomers, and vinyl monomers (see Examples 1-3, 11, and 12). A range of weight percentages of the monomers is presented (see col. 2, lines 13-60). While applicant claims organic solvents as additives in the instant claims, the same substances are alternately known as plasticizers in the prior art. For example, Mondet teaches the use of diethylene glycol butyl ether as a plasticizer, as well as the use of dibutyl adipate (see col. 4, lines 21-67). Note dibutyl adipate is disclosed herein at paragraph [72] as one of the second solvent. The use of plasticizers in conjunction with the copolymer is claimed (see claim 18). While Mondet does not disclose the boiling points of the plasticizers, the compounds taught by Mondet necessarily meet the claimed boiling points, since the actual compounds are the same as claimed in the instant application, and a compound has the same physical properties whether the compound is described as a solvent or a plasticizer. Compositions in the form of products for making up the nails such as nail varnishes are taught. Example 11 discloses a mascara comprising particles of an aqueous dispersion of copolymer.

Conventional cosmetic additives are taught, such as pigments, thickeners, and additives. While Mondet claims the use of at least one plasticizer, the reference lacks specifically claiming two plasticizers, as well as the same range of weight percentages of components as claimed, as well as the full scope of components as claimed.

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It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the compositions of Mondet by routine optimization of weight percentages in order to benefit from the formulation of nail varnishes and Lacquers. The motivation for the additional components comes from Mondet, which teaches that cosmetic additives such as pigments, thickeners, and additives are conventionally added when formulating nail lacquers. The missing ingredients have art-recognized suitability for the intended purpose of formulating a nail lacquer. The selection of a known material based on its suitability for its intended use has been determined to be prima facie obvious. See *Sinclair & Carroll Co. v. Interchemical Corp.*, 325 U.S. 327, 65 USPQ 297 (1945)*, *In re Leshin*, 227 F.2d 197, 125 USPQ 416 (CCPA 1960); and MPEP 2144.07.

In response to appellant's argument that there is no suggestion or motivation to modify the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) And *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation or suggestion is found both in the prior art, and in the knowledge generally available to one of ordinary skill in the art. Particularly, the reference **teaches** the combination of the polymer and **at least one** "plasticizer" (or "organic solvent"). The reference also teach the particular solvents herein are amount the few suitable plasticizers, and as stated above, The selection of a known material based on its suitability for its intended use has been determined to be prima facie obvious.

It is noted that Mondet not only state that the cosmetic composition can “optionally contain a plasticizer,” Mondet et al also specifically claim a composition comprising at least one plasticizer (see claim 18). Mondet et al teach the combination of the polymer and plasticizer.

Appellants assert “the office has continued to mischaracterize the instant claimed invention as “a combination of two known ‘plasticizers,” but fail to point out the alleged error. As discussed above the two “solvents” herein are the same as the plasticizers employed by Mondet et al.

Appellants argue that rejections based on Kerkoven are not appropriate and Kerkoven is not applicable. Specifically, appellants state ‘it appears that the office would rather rely on Kerkoven than produce the objective arguments necessary to establish a prima facie case of obvious.” (page 9 of the appeal brief). This is incorrect. The objected evidences have been provided by Mondet et al.: A composition comprising the polymer and at least one plasticizer and the particular solvents herein are among the few suitable plasticizers therein. Kerkoven or *Sinclair & Carroll Co. v. Interchemical Corp.* are cited to show a well recognized knowledge generally available to one of ordinary skill in the art. Particularly, it is prima facie obvious to combine two compositions each of which is taught in the prior art to be useful for same purpose in order to form third composition that is to be used for very the same purpose; idea of combining them flows logically from their having been individually taught in prior art; thus, the claimed invention which is a combination of two known “plasticizers”, which are known to be beneficial to the film-forming composition, sets forth prima facie obvious subject matter. See In re Kerkhoven, 205 USPQ 1069; The selection of a known material based on its suitability for its intended use has been determined to be prima facie obvious. See *Sinclair & Carroll Co. v.*

Interchemical Corp., 325 U.S. 327, 65 USPQ 297 (1945)*, In re Leshin, 227 F.2d 197, 125 USPQ 416 (CCPA 1960); and MPEP 2144.07.

1. Appellants further argue that the two different solvents have different functions (coalescing agent and plasticizer), which are not disclosed in the cited reference, thus the claimed inventions would have not been obvious over the cited prior art. The arguments are not persuasive. It is well settled patent law that mode of action elucidation does not impart patentable moment to otherwise old and obvious subject matter. Applicant's attention is directed to In re Swinehart, (169 USPQ 226 at 229) where the Court of Customs and Patent Appeals stated "is elementary that the mere recitation of a newly discovered function or property, inherently possessed by thing in the prior art, does not cause a claim drawn to those things to distinguish over the prior art." The ultimate utility for the claimed compounds (used with the polymer in cosmetic composition) is old and well known rendering the claimed subject matter obvious to the skilled artisan. It would follow therefore that the instant claims are properly rejected under 35 USC 103. Appellants' assertion about the combination of the two particular "solvents": "such criticality having thus demonstrated,..." is improper. No criticality residing on the particularly combination has been demonstrated.

2. Appellants contend that Kerkoven differ from instant situation in that the end product in Kerkhoven was the same as the two ingredients: a detergent; and in the present invention, the end product is a cosmetics, not a solvents. Appellants' analysis is improper. The gist of Kerkoven is: it is prima facie obvious to combine two compositions each of which is taught in the prior art to be useful for same purpose in order to form third composition that is to be used for very the same purpose; idea of combining them flows logically from their having been

individually taught in prior art. Whether the combination is for later use (in Kerkoven), or is used in situ (in the invention) is not relevant.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). As discussed above, one of ordinary skill in the art would have arrived at the claimed invention solely based on the cited reference and knowledge which was within the level of ordinary skill at the time the claimed invention was made. Again the examiner contends that the alleged function of one of the solvents would not make the otherwise obvious subject matter patentable.

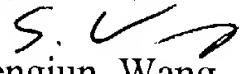
Appellants' allegation that the prior art reference would have revealed no reasonable expectation of success in making the claimed invention is groundless. Particularly, the instant claims are drawn to a cosmetic composition comprising known cosmetic ingredients. Appellants have not disclosed any particularly procedure in making the claimed composition which is not known, or not obvious to a skilled artisan. As to the remarks of "picking and choosing," note the teaching of Mondet et al. is not a "needle-in-the-haystack" type of disclosure, but a very limited group. Further, in view of claimed scope, it is noted that any organic compound with bp 100 °C or greater would be definitely in one of the two groups of solvents.

For the above reasons, it is believed that the rejections should be sustained.

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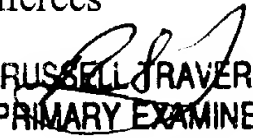
Respectfully submitted,


Shengjun Wang
Primary Examiner
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**SHENGJUN WANG
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May 31, 2004

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